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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 18

Serial Number: 08/603,497
Filing Date:
Appellant(s): Morini et al.

James C. Lydon
For Appellants

EXAMINER'S ANSWER

This is in response to appellants' brief on appeal filed October 3, 1997.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on October 3, 1997 has been entered.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-6, 8-20 and 22-29 stand or fall together because appellants' brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,122,492	Albizzati (492)	6/92
5,068,213	Albizzati (213)	11/91
4,978,648	Barbe	12/90
2-242,804 (Japan)	Denko	9/90

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims.

Claims 1-6, 8-20 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albizzati (492), Albizzati (213) and Barbe altogether or all in view of Denko.

Albizzati (213) generically teaches the use of the claimed diethers as external electron donors in the claimed titanium component (column 2, lines 3-8, lines 54-60). While this description does not specifically state that the ring formed from bonding the X and the Y radicals can be unsaturated, this recitation along with that at column 2 lines 3-8 suggests that this ring could have a plurality of double bonds. It is certainly clear that the recitation at column 2, lines 3-8 (as well as claim 1 of this patent) generically includes the claimed diethers.

Since Albizzati (492) (column 4, lines 17-20) and Barbe (column 3, lines 7-11) teach some analogous compounds of Albizzati (213) not containing any unsaturation, e.g., 1,1-bis(methoxymethyl)-cyclohexane, -bicyclo[2,2,1]heptane and -cyclopentane (Albizzati (492), column 4, lines 17-20) it would be obvious for one of ordinary skill in the art to realize that the analogous compounds containing a plurality of unsaturation in the

ring would make suitable diethers for use in the catalyst of these references, e.g., a cyclopentadiene ring.

The motivation to realize that diethers having multiunsaturated cyclic rings in place of the saturated cyclic rings would also be suitable ethers for the catalysts of the reference is supplied by Denko who teaches that the analogous 1,1-diethers having a cyclopentadiene ring attached to both of the oxygen atoms is a suitable diether for the same use as the claimed diethers.

The embodiments of the remaining claims are either disclosed by the references or obvious therefrom.

Contrary to appellants' allegations, one would be motivated to modify the cyclic group containing diethers of Albizzati (492) by the teaching of Albizzati (213) and by the teachings of Denko.

Appellants continually urge that these cyclic group containing diethers disclosed by the references are "non-preferred" and thus teach "away" from the invention diethers. While they are obviously not the preferred species, they are taught to be suitable and must be considered in evaluating the patentability of the claims. In re Miller et al. 176 USPQ 196.

CONCLUSION

Appellants' appeal should be denied because the art of record establishes a prima facie case of obviousness which has not been rebutted.

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